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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/830,197

04/21/2004

Andy C. Wu

9359

25859

7590

04/21/2006

WEI TE CHUNG  
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EXAMINER

HASSAN, AURANGZEB

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/830,197	<b>Applicant(s)</b> WU, ANDY C.	
	<b>Examiner</b> Aurangzeb Hassan	<b>Art Unit</b> 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/21/2004.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Supervisory* FRITZ FLEMING  
PRIMARY EXAMINER  
GROUP 2100 4/4/2006  
44281

## DETAILED ACTION

### *Specification*

1. The examiner objects to the specification in reference to citation of wireless communication protocol standards. The examiner's understanding according to paragraph [0020] is that applicant is citing MP3 (Moving Picture Experts Group, audio layer 3) module to reflect a wireless communication standard. The examiner accordingly objects to the specification, as the MP3 standard does not necessitate wireless communication capabilities.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/829,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/829,913 claims 1-19 contain every element of the identified claims of the instant application and as such anticipates the identified claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 – 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In reference to claims 1, 8, 9, 11, 17, 18, and 20, according to Merriam-Webster's, analogical is defined as either relating to or based on analogy, or expressing

Art Unit: 2182

or implying analogy. Analogical is not a term of art and is not enabled as according to definition of pertaining to an analogy.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In reference to claims 1, 8, 9, 11, 17, 18, and 20, due to the rejection above under 35 U.S.C. 112, first paragraph the meets and bounds of the claims cannot be determined and are not in line with terminology of art. The examiner notes broadest reasonable interpretation of an “analogical switch” to be hereinafter examined as a “switch.”

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-5, 7-14, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (US Publication Number 2005/0083741, hereinafter "Chang").

10. As per claims 1, 2, and 11, Chang teaches a universal serial bus (USB) apparatus comprising: a USB interface module for connecting to a USB interface of a host (each USB peripheral device internally contains a USB microcontroller that performs functionality associated with identifying the device to a host, paragraph [0006]); a memory module for reading and writing data (paragraph [0016]); at least a USB module (USB wireless device, [0031]); and a switch module for switching the memory module and said USB module (figure 7), the switch module further comprising: a mechanical switch (physical slide switch, element 700, figure 7); a first switch for connecting with the memory module; and a second switch for connecting with said USB module; wherein the mechanical switch is for controlling switching between the first switch and the second switch (various switch positions between wireless and memory modules, paragraph [0044]).

11. As per claims 3 and 12, Chang teaches an apparatus wherein said USB module is a wireless communication module for accessing a wireless local area network (WiFi, paragraph [0031]).

12. As per claims 4 and 13, Chang teaches an apparatus wherein the USB

apparatus can be operated in any one of the following three modes: a memory operating mode (position 710, figure 7, paragraph [0044]), a wireless communication operating mode (position 720, figure 7, paragraph [0044]), and an interruption mode (position 730, figure 7, paragraph [0044]).

13. As per claims 5 and 14, Chang teaches an apparatus wherein the memory module for reading and writing data is a flash memory or an electrically erasable programmable read only memory (compact flash, figure [0016]).

14. As per claims 7 and 16, Chang teaches an apparatus wherein the mechanical switch comprises a memory port (port for element 630, figure 6), a wireless communication port (port for element 640 & 650, figure 6) and an interruption port (based on auto run software, upstream port, element 600, figure 6).

15. As per claims 8 and 17, Chang teaches an apparatus wherein when the mechanical switch is switched to the memory port, this sets up communication between the first switch and the memory module, and the USB apparatus operates in memory operating mode (position 710, figure 7, paragraph [0044]).

16. As per claims 9 and 18, Chang teaches an apparatus wherein when the mechanical switch is switched to the wireless communication port, this sets up communication between the second switch and the wireless communication module,

and the USB apparatus operates in wireless communication operating mode (position 720, figure 7, paragraph [0044]).

17. As per claims 10 and 19, Chang teaches an apparatus wherein when the mechanical switch is switched to the interruption port, this interrupts memory operating mode or wireless communication operating mode, and the USB apparatus operates in interruption mode (position 730, figure 7, paragraph [0044]).

18. As per claim 20, Chang teaches a method for switching a universal serial bus (USB) apparatus (USB memory device implementation, paragraph [0016]), the method comprising the following steps: (a) selecting an operating mode parameter for the USB apparatus, the operating mode parameters comprising a memory operating parameter (paragraph [0016]), a wireless communication operating parameter (USB wireless device, [0031]) and an interruption mode parameter (auto run, paragraph [0017]); and (b) if the memory operating parameter is selected: (physical slide switch, element 700, figure 7) (b1) switching a mechanical switch to a memory port, and enabling a first switch to drive a memory module (position 710, figure 7); and (b2) setting up communication between a USB interface module and the memory module (position 710, figure 7, paragraph [0044]); (c) if the wireless communication operating parameter is selected: (c1) switching the mechanical switch to a wireless communication port, and enabling a second switch to drive a wireless communication module (position 720, figure 7); and (c2) setting up communication between the USB interface module and the



Art Unit: 2182

wireless communication module (position 720, figure 7, paragraph [0044]); and (d) if the interruption mode parameter is selected: (d1) switching the mechanical switch to an interruption port (position 730, figure 7); and (d2) interrupting a memory operating mode or a wireless communication operating mode of the USB apparatus (position 730, figure 7, paragraph [0044]).

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Moores, JR. et al. (US Publication Number 2003/0043042 hereinafter "Moores").

21. As per claims 6 and 15, Chang teaches an apparatus wherein said USB module is a wireless communication module.

Chang fails to teach an apparatus wherein said USB module is an MP3 (Moving Picture Experts Group, audio layer 3) module or a radio frequency identifier module.

In an analogous apparatus, Moores teaches an apparatus wherein said USB

module is an MP3 (Moving Picture Experts Group, audio layer 3) module or a radio frequency identifier module (short-range wireless technology, paragraph [0149]).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the teachings of Chang with the above teachings of Moores. One of ordinary skill in the art would have been motivated to make such modification in order to allow for compatibility in a non-limiting factor to allow for backward compatibility for a legacy mode of short-range communication from Bluetooth and WiFi to RFID as they are tiny cheap and easy to deploy (paragraphs [0151-0152]).

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Publication Number 2002/0169915 expresses a various mode detection and manual selection means for a USB hub. The examiner asserts various USB devices (modules) may be attached to the USB hub at the user's discretion. US Patent Number 6,944,687 teaches a USB device comprising a USB interface, radio component and a memory.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aurangzeb Hassan whose telephone number is (571)272-8625. The examiner can normally be reached on Monday - Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571)272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AH  
4/11/2006

*Supervisory*  
*Fritz Fleming*  
FRITZ FLEMING  
PRIMARY EXAMINER 4/14/2006  
GROUP 2100  
AU 2181